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REMARKS

The present amendment is prepared in accordance with the new revised requirements of 37 C.F.R. § 1.121.   A complete listing of all the claims in the application is shown above showing the status of each claim. For current amendments, inserted material is underlined and deleted material has a line there through.

Applicants appreciate the thoroughness with which the Examiner has examined the above-identified application. Reconsideration is requested in view of the amendments above and the remarks below.

For purposes of appeal, no claims have been amended.

Claim Rejections - 35 USC § 103

The Examiner has rejected claims 1-7 and 9-20 under 35 U.S.C. 103 as being unpatentable over Corbin U. S. Patent No. 5,138,712, in view of McGuire et al. U. S. Patent No. 6,493,871 and further in view of Misra et al. U. S. Patent No. 6,189,146 B1, while claim 8 is rejected under 35 U.S.C. 103 as being unpatentable further in view of Bartholomew et al. U. S. Patent No. 6,202,209 B1.

The Corbin Patent

Corbin U. S. Patent No. 5,138,712 is directed to a system for requiring and granting licenses to run software applications that <u>already exist</u> on the computer storage device on which

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they are to be executed. See, Corbin, Col. 6, ll. 35-56. It is directed to protecting against the unauthorized use of software in a concurrent-use licensing environment. (Col. 2, ll. 30-33.) It discloses providing the software application itself with the verification and license check out functions, which are normally performed by a license server of a network software license system. (Abstract, col. 2, ll. 30-34, col. 4, ll. 32-37, col. 7, ll. 1-4.)

In particular, Corbin discloses a license service 14 that is shared by every agent connected to a computer network environment. (Col. 5, ll. 7-9.) The shared license service 14 includes license servers and databases that store licensing information for various software applications that are purchased and authorized to run in the computer network environment. (Col. 5, ll. 10-30.) Each license server 20 operates on an agent and interfaces the database 18 to a license administration tool 21, licensing library 24 and license service binder 29. (Col. 6, ll. 8-13.) The licensing library 24, comprising a set of library routines, is linked with the application 26 and communicates with the license server 20 for enabling the application 26 to request licensing service from the license server 20. (Col. 6, ll. 35-37 and 40-44.) Upon receiving the request for service from the licensing library 24, the license server 20 retrieves a license token from the database 18 and transmits it to the licensing library 24. (Col. 6, ll. 37-40.)

As disclosed in Corbin, "[t]he application is installed and linked to the licensing library using standard operating system utilities of the agent executing the licensing library and the application." (Col. 6, ll. 49-52, See also, col. 6, ll. 62-66.) That is, the application is installed on the agent connected to the computer network whereby the "licensing library coupled to the application performs the procedure of authenticating the license token prior to granting a license and therefore access to run the application." (Col. 11, ll. 64-67.)

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Again, when the already-installed application is to be executed, it is a license token, and not the application, which is downloaded from the license server. See, Corbin Fig. 3 and col. 7, ll. 46 to col. 8, l. 25. ("Applications 41, 42 and 43 are shown requesting licensing service from the license server 44. When a customer purchases a license for an application, ... the software vendor creates a license token with a license production tool, and delivers the license token to the customer's network administrator. ... The license sever is now ready to entertain requests from application 41, 42 and 43 for a license to use the application corresponding to token 46 as well as other applications represented in database 46.")

The McGuire Patent

McGuire is directed to an improved method for downloading updates for software programs already installed on a client computer. (Col. 4, ll. 13-16.) The client computer first obtains from a setup server an initial setup package, which includes a setup program and a list of files required for installing the software product on the client computer. (Col. 4, ll. 17-21.) The setup program running on the client computer determines whether some current or earlier versions of those files required for installation already exist on the client computer, and compiles a download request with a list of files needed for updating the client to provide the required installation files. (Col. 4, ll. 21-27.) The download request is sent to a second server storing a collection of update data, and in response, the second server prepares and downloads update files corresponding to the requested files to the client, whereby the setup program updates the existing files to create and install the revised software product on the client computer. (Col. 4, ll. 27-37.) McGuire teaches that:

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[T]he client computer first downloads from a setup server 76 an initial startup package 80, which includes a setup program 82 and information 84 regarding files which are potentially required for installing the revised software product. ... Based on the installation information and the existing files, the setup program 82 determines which files are needed to add to or update the existing files to provide the set of installation files, and compiles a "needed files" list. ... The download server 70 maintains a database of update data 92 for the software product that can be downloaded upon request. · When the download server 70 receives the download request, it compares the list of needed files with available update data, and returns update files 96 to the client. After receiving the download reply, the setup program uses the files in the download reply to update the existing files to generate on the client computer the required installation files. The desired revised version of the software product is then installed on the client computer. (Col. 7, ll. 28-56.)

The Misra Patent

Misra is directed to systems and methods for enforcing software licenses and preventing copying of software licenses —not preventing copying of the software itself, as is currently claimed. (Col. 1, ll. 6-8.) Misra discloses that when a company 24 wants a software license to run software on the company computers, it sends a purchase request to a licensing clearinghouse 22. The licensing clearinghouse 22 has a license generator 26 that creates a license pack containing a set of one or more individual software licenses. (Col. 2, ll. 32-36 and col. 4, ll. 1-8.) The license pack is sent to the company 24, whereby the company 24 has a license server 28. The license server 28 maintains an inventory of software licenses that have been purchased form the licensing clearinghouse 22. (Col. 4, ll. 9-23.) In so doing, the license server 28 monitors the software licenses that have been granted to clients and distributes licenses to new clients as long as it has available non-assigned licenses. (Col. 4, ll. 23-30.)

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An intermediate server 32 connects the clients to the license server 28. (Col. 4, ll. 31-48.) Once connected thereto, the client must present a valid license, whereby if the client does not have an appropriate license, the intermediate server 32 assists the client in obtaining a license from the license server 28 (whether the license is a new license or a recovered license. (Col. 4, ll. 49-64.) To prevent the software license from being copied from one client machine to another, the software license is assigned to the specific client by including its client ID within the license. The software license also has a corresponding license ID that is associated with the client ID in the client assignment table in the secure license store at the license server. (Col. 15, ll. 29-36.) Once a client 30 obtains a license, the client is responsible for managing the storage of that license. (Col. 4, ll. 64-66.)

In the Summary of the Misra patent, it is also disclosed that to prevent the license pack (i.e., not the software) from being copied and installed on multiple license servers (from one client machine to another), a unique license pack ID is assigned to the license pack and associates the license pack ID with the license server in a secure master license database kept at the licensing clearinghouse. (Col. 2, ll. 37-41 and col. 15, ll. 29-32.) In preventing copying of the license pack, the license generator also digitally signs the license pack and encrypts it with the license server's public key. (Col. 2, ll. 41-43.)

Claims 1 - 7 and 9 - 20

The Examiner has rejected claims 1-7 and 9–20 under 35 U.S.C. 103(e) as being unpatentable over Corbin U. S. Patent No. 5,138,712, in view of McGuire et al. U. S. Patent No. 6,493,871 131 and further in view of Misra et al. U. S. Patent No. 6,189,146 B1.

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Applicant continues to submit that the present invention is directed to installing licensed software on a client or end user's personal computer using a scripted network installation routine that verifies the client or end user has a valid license to install such software. (Specification, pg. 7, ll. 21-28.) As recited in the currently pending claims, the instant invention is directed to installing licensed software on an end user's computer by first providing an end user computer having a program storage device and a unique computer identifier distinguishing this end user computer from other computers. Also provided is a network computer having access to a program storage device containing software programs to be executed by the end user's computer and database information for license to end users, and a program storage device containing a database listing computer identifiers licensed to run the software. The end user computer is then contacted using the network computer to determine its end user computer identifier, and next, listing of this end user computer identifier in the network computer database is verified. Based on such verification, software is then downloaded from the network computer program storage device. Using the network computer, the downloaded software is then installed on the end user computer program storage device such that the downloaded and installed software is not in a form that may be transferred from the end user computer and installed on another computer.

Applicant's scripted network installation routine invention for installing licensed software on a client computer enables management of the distribution of licensed software, improves control over installation of licensed software, and verifies the propriety of distributing licensed software to an end user computer. (Specification, pg. 1, ll. 21-27 and pg. 7, ll. 21-28.) It also reduces the opportunity to improperly copy and distribute licensed software to unlicensed end user computers. (Specification, pg. 2, ll. 3-5 and pg. 7, ll. 21-28.) The instant invention

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advantageously allows for the central control of the installation of licensed software while requiring no additional software to be installed and run on the end users personal computer. A particular advantage of the invention is that the software to be installed is never present on the end user computer in a form in which it might be transferred and installed on another personal computer, i.e., the end user does not physically have the installation media for the selected software. Rather, the installation media is held in the central location of the network computer and is in the control of such network computer, which directly installs the program to the end user computer. (Specification, pg. 11, l. 13 to pg., 12, l. 7.)

Applicant continues to assert that the Examiner has not established a *prima facie* case of obviousness under the standards of 35 USC § 103(a).

Applicant submits that "[o]bviousness is tested by 'what the combined teaching of the references would have suggested to those of ordinary skill in the art.' (*quoting In re Keller*, 642 F.2d 413, 425, 208 U.S.P.Q. 871, 881 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." (*quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)). And "teachings of references can be combined only if there is some suggestion or incentive to do so." (*quoting, Id.*)." *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

Further, it is improper to. focus on the obviousness of individual components or substitutions, rather than on the invention as a whole, *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1448, 223 USPQ 603, 610 (Fed. Cir. 1984); *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 724, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). "[A]

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rejection cannot be predicated on the mere identification ...of individual components of claimed

limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no

knowledge of the claimed invention, would have selected these components for combination in

the manner claimed."). *Ecolochem Inc. v. Southern California Edison*, 227 F.3d 1361, 1374, 56

USPQ2d 1065, 1075 (Fed. Cir. 2000). Hindsight based on reading of the patent in issue may not

be used to aid in determining obviousness. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721

F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *Orthopedic Equipment Co. v. United

States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983). "One cannot use hindsight

reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the

claimed invention." *In re Fine*, 837 F.2d at 1075, 5 U.S.P.Q.2d at 1600. Likewise, hindsight and

the level of ordinary skill in the art may not be used to supply a component missing from the

prior art references. *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 1324, 50 USPQ2d

1161, 1171 (Fed. Cir. 1999).

The Examiner takes the position that Corbin discloses the claimed limitation of "

downloading the executable software program or database..."; however, the Examiner does not

consider the entire limitation, namely, "verifying listing of the end user computer identifier in the

network computer database" and "based on the verification that the end user computer identifier

is listed in the network computer database, downloading said software from the network

computer program storage device." See, *Kimberly-Clark Corp.* 745 F.2d at 1448, 223 USPQ at

610. That is, as is currently recited in each and every independent claim, applicant's invention is

directed to, prior to downloading the software (i.e. application of Corbin), verifying licensing,

and then based on such verification, downloading from a network computer and installing to the

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end user's computer such software which comprises either programs to be executed by the end user's computer or database information.

On the contrary, Corbin discloses a system in which, at the time the license is checked, the executable software applications to be used are already present on the computer storage device on which they are to be executed. See, Corbin col. 6, ll. 35-56. ("The licensing library 24 is a set of library routines which enable the application 26 to request licensing service from the license server 20. ... The application is installed and linked to the licensing library using standard operating system utilities of the agent executing the licensing library and the application.") See also, Corbin col. 7, ll. 50-51. ("Applications 41, 42 and 43 are shown requesting licensing service from the license server 44.") When the already-installed application is to be executed, it is a license token, and not the application, which is downloaded from the license server. See, Corbin Fig. 3 and col. 7, ll. 46 to col. 8, l. 25. ("Applications 41, 42 and 43 are shown requesting licensing service from the license server 44. When a customer purchases a license for an application, ... the software vendor creates a license token with a license production tool, and delivers the license token to the customer's network administrator. ... The license server is now ready to entertain requests from application 41, 42 and 43 for a license to use the application corresponding to token 46 as well as other applications represented in database 46.") Additionally, the Examiner has recognized, "Corbin doesn't explicitly disclose, software selected from the group consisting or [sic; of] programs to be executed by the end user's computer and database information."

Applicant submits that the passages of Corbin cited by the Examiner, namely, col. 2, ll. 60-65 "When a user wishes to run a software application, the licensing library invokes a call to

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request a license token from the license server," and col. 6, ll. 62– 67 "The application integrated

with the application specific license access module (LAM) 27 may be distributed by the software

vendor for installation on one of the computers in the network using any well known distribution

medium in the art" should not be taken out of context and relied upon by the Examiner with the

benefit of hindsight to show obviousness. "It is impermissible within the framework of section

103 to pick and choose from any one reference only so much of it as will support a given

position, to the exclusion of other parts necessary to the full appreciation of what such reference

fairly suggests to one of ordinary skill in the art." *Bausch & Lomb, Inc. v. Barnes-*

Hind/Hydrocurve, 796 F.2d 443, 449-50, 230 USPQ 414, 420-421 (Fed. Cir. 1986), cert. denied,

484 U.S. 823 (1987); *quoting In re Wesslau,* 353 F.2d 238, 241, 147 USPQ 391, 393 (C.C.P.A.

1965).

Accordingly, applicant submits that it is impermissible for the Examiner to only cite the

above-cited lines of Corbin with the exclusion of the remainder of the Corbin patent which

teaches that the executable software applications must be already present on the computer

storage device on which they are to be executed prior to downloading a license token. (See,

Corbin, col. 6, ll. 35-56, col. 7, l. 46 to col. 8, l. 25, and Fig. 3.) In fact, as recited on page 7 of

the above-identified office action, the Examiner recognizes that "Corbin shows *when running*

the software program verifying the license and upon verification *transmitting the license* for the

software application." That is, when the Examiner considers the teachings of the Corbin patent

as a whole, the Examiner recognizes that the software application exists on the client computer

(*when running the software program*) prior to verifying licensing and transmitting a license

token for the software application. *See, Id.* Applicant submits that Corbin does not disclose,

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contemplate or suggest the invention as a whole which, as is currently claimed, is directed to installing licensed software on an end user's computer having a unique computer identifier by first verifying listing of this end user computer identifier in a network computer database, and based on such verification, downloading from the network computer program storage device and installing such software on the end user computer program storage device such that the downloaded and installed software is not in a form that may be transferred from the end user computer and installed on another computer. *See, Kimberly-Clark Corp,* 745 F.2d at 1448, 223 USPQ at 610 ("it is improper to focus on the obviousness of individual components or substitutions, rather than on the invention as a whole").

In attempting to overcome the deficiencies of Corbin as cited by the Examiner (i.e., "that Corbin doesn't explicitly disclose software selected from the group consisting of programs to be executed by the end user's computer and database information", the Examiner continues to cite McGuire to remedy this deficiency.

Applicant continues to submit that McGuire is limited to methods and systems for downloading updates for software programs already installed on a client computer. (Col. 4, lines 13-16.)   McGuire teaches that a setup program is initially installed and running on the client computer for making requests to a second server. The client computer requests only the updated files needed to be downloaded from the server, and not the entire program. McGuire does not disclose, contemplate or suggest installing licensed software on an end user's computer having a unique computer identifier by first verifying listing of this end user computer identifier in a network computer database, and based on such verification, downloading and installing such software on the end user computer program storage device such that the downloaded and

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installed software is not in a form that may be transferred from the end user computer and installed on another computer, as is currently claimed. Further, the server or network computer of McGuire does nothing to contact the end user computer to determine its identifier and verify that the end user is listed in a network computer's database as licensed to download the software, and it does not actually install the downloaded software, since this is done by the client or end user computer. It is for these reasons that applicant submits that McGuire does not overcome the deficiencies of the Corbin patent as discussed above by applicant.

Further in the above office action, the Examiner states that Corbin as modified by Mcguire doesn't disclose that the downloaded and installed software is not in a form that may be transferred from the end user computer and installed on another. To remedy this deficiency, the Examiner cites Misra, stating that it "discloses this functionality in analogous art (Col. 15: 27-35)."

The fact that references are in the same art is an insufficient basis on which to combine the references. *In re Levitt* (CAFC 1989) 11 USPQ 2d 1315. It should be appreciated that the fact that a claimed product or process is within the broad field of the prior art and that one might arrive at it by selecting specific items and conditions does not render the product obvious in the absence of some directions or reasons for making such selection. *Ex parte Kuhn* (POBA 1961) 132 USPQ 359.

Applicant submits that Misra does not overcome the above discussed deficiencies of Corbin and/or McGuire. Misra is limited to systems and methods for enforcing software licenses and preventing copying of software licenses or license packs —not preventing copying of the software itself, as is currently claimed. (Col. 1, ll. 6-8.) Misra discloses to prevent the <u>software</u>

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license or license pack from being copied from one client machine to another software license is

assigned to the specific client by including its client ID within the license or a unique license

pack ID is assigned to the license pack and associates the license pack ID with the license server

in a secure master license database, respectively. (Col. 2, ll. 37-43, col. 4, ll. 1-64 and col. 15, ll.

29-36.) Misra does not disclose, contemplate or suggest installing licensed software on an end

user's computer having a unique computer identifier by first verifying listing of this end user

computer identifier in a network computer database, and based on such verification,

downloading and installing such software on the end user computer program storage device such

that the downloaded and installed software is not in a form that may be transferred from the end

user computer and installed on another computer, as is currently claimed.   Misra does not

overcome the deficiencies of Corbin or McGuire, alone or in combination.

Additionally, with respect to claims 2 and 10, the Examiner states that Corbin discloses

that the unique computer identifier is selected from the group consisting of a BIOS serial number

and a network adapter address (Col. 9: ll. 5 -10, for addressee host name and domain, for Bios

serial number, see host ID). Applicant submits, as will be appreciated by one skilled in the art,

that a BIOS number is not the same as a host ID number.   As understood in the art, a BIOS

serial number is a pre-installed ID that comes with the BIOS ("Basic Input/Output System")

program (also pre-installed in the computer during manufacture), which is stored in read-only

memory for enabling a computer to start the operating system and to communicate with the

various devices in the system, such as disk drives, keyboard, monitor, printer, and

communications ports.   In contrast, a host ID is an end-station identifier that is generally

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arbitrarily assigned by a local area network (LAN) administrator – it is not a BIOS serial number.

The Examiner also continues to reject claim 8 under 35 U.S.C. 103(a) as being unpatentable over Corbin USPN 5,138,712, in view of McGuire et al. USPN 6,493,871 BI, further in view of Misra et al. USPN 6,189,146 as applied in claim 1, and further in view of Bartholomew et al. USPN 6,202,209 Bl.

Applicant continues to submit that claim 8, dependent on claim 1, specifies that the end user computer program storage device contains a damaged version of the software to be downloaded, and that the installation of said software corrects the damaged software. For the reasons discussed above in connection with claim 1, the hypothetical combination of Corbin's download of only a license token to an already-installed software application, McGuire's use of a setup program already installed at the end user's computer, with no license verification, and Misra's preventing of a license pack from being copied and installed from one client machine to another, does not disclose or suggest applicant's claimed downloading of the entire executable software program to replace a damaged version of the executable software. Bartholomew is directed to a PCMCIA personal information device, and not to downloading of licensed software. Bartholomew's disclosure does not correct the deficiency of the Corbin, McGuire and Misra references, and therefore the hypothetical combination does not arrive at applicant's invention as specified in claim 8.

In summary, applicants submit that the Examiner has merely locating references that indicate isolated elements of applicants' invention, yet none of these cited references, alone or in any proper combination thereof, disclose or suggest the present invention, nor do they alone or in

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any combination provide any motivating force which would impel a person skilled in the art to do what applicants have done. *Ex parte Levengood* (BPAI 1993) 28 USPQ 2nd 1300. Neither Corbin, McGuire or Misra, alone or in any proper combination thereof, disclose, contemplate or suggest installing licensed software on an end user's computer having a unique computer identifier using a scripted network installation routine by first verifying listing of this end user computer identifier in a network computer database, and based on such verification, downloading and installing such software on the end user computer program storage device such that the downloaded and installed software is not in a form that may be transferred from the end user computer and installed on another computer, as is currently claimed.

That is, none of the cited references, alone or in any proper combination thereof, teach, suggest or infer, nor is there knowledge generally available to one of ordinary skill in the art which would have led one to combine the teachings of the references to render applicant's claimed invention. *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc. et al.* (CAFC 1985) 227 USPQ 657. Again, hindsight based on reading of the patent in issue may not be used to aid in determining obviousness. *W.L. Gore,* 721 F.2d at 1553, 220 USPQ at 312-13. Also, hindsight and the level of ordinary skill in the art may not be used to supply a component missing from the prior art references. *Al-Site Corp.,* 174 F.3d at 1324, 50 USPQ2d at 1171.
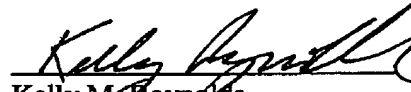
In view of the foregoing, and under the applicable law, it is respectfully submitted that the claims are properly allowable under 35 USC 103.

It is for these reasons that applicants submit that the application is in a condition where allowance of the case is proper. Reconsideration and issuance of a Notice of Allowance are respectfully solicited. Should the Examiner not find the claims to be allowable, Applicants'

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attorney respectfully requests that the Examiner call the undersigned to clarify any issue and/or

to place the case in condition for allowance.

Respectfully submitted,

Kelly M. Reynolds
Reg. No. 47,898

DeLIO & PETERSON, LLC
121 Whitney Avenue
New Haven, CT 06510-1241
(203) 787-0595
ibmf100268000amdE-af